

**\*E-FILED 10/24/2007\***

NOT FOR CITATION  
IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

VERIGY US, INC.,

No. C07-04330 RMW (HRL)

Plaintiff,

**ORDER ON PLAINTIFF'S MOTION TO  
COMPEL**

v.

ROMI OMAR MAYDER, WESLEY  
MAYDER, SILICON TEST SYSTEMS, INC.,  
and SILICON TEST SOLUTIONS, LLC,

**[Re: Docket No. 37]**

Defendants.

Plaintiff Verigy US, Inc. ("Verigy") sues for alleged trade secret misappropriation by defendants Romi Mayder (plaintiff's former employee); his brother, Wesley Mayder; and the new companies they formed, Silicon Test Systems, Inc. and Silicon Test Solutions, LLC. The District Court is scheduled to hear Verigy's motion for preliminary injunction on November 9, 2007.<sup>1</sup> In the meantime, Verigy has been given leave to conduct some expedited discovery. Additionally, defendants have been ordered to preserve all evidence, including all information contained on their computer hard drives.

The parties presently are before this court on Verigy's expedited motion to compel defendants Romi Mayder and Silicon Test Systems, Inc. to produce bit-for-bit copies (i.e.,

<sup>1</sup> The parties have since stipulated to a brief continuance of the preliminary injunction hearing and some of the related briefing deadlines.

1 mirror images) of all hard drives.<sup>2</sup> Defendants oppose the motion. There is no dispute that  
2 discovery of bit-for-bit copies should be allowed, albeit defendants contend that it is  
3 unnecessary. However, the parties disagree about how inspection and production are to  
4 proceed.

5 According to defendants, there are two hard drives in question. In July 2007, they  
6 reportedly made bit-for-bit copies of those hard drives (including recovered deleted files and  
7 fragments) and produced documents responsive to plaintiff's requests. Plaintiff is skeptical  
8 about the production. It says that, to date, defendant Romi Mayder has produced only one email  
9 pertaining to his work at Silicon Test Systems, Inc. whereas Bob Pochowski, a third-party  
10 witness, has produced a host of documents (emails, data sheets, and the like) from Mayder that  
11 apparently were created during Mayder's employment at Verigy. Verigy also contends that  
12 other documents produced to date demonstrate Mayder's willingness to manipulate evidence.  
13 Plaintiff also asserts that, when defendant Mayder left plaintiff's employ, a system or software  
14 upgrade was performed which may have deleted files from defendants' hard drives. Verigy  
15 argues that it needs to conduct additional discovery of those hard drives, not only to determine  
16 whether any relevant documents have been withheld from defendants' production, but also to  
17 examine what may have happened on the hard drives and why.

18 Defendants contend that plaintiff is merely casting aspersions. They do not dispute that  
19 a system or software upgrade was performed which may have deleted files from their hard  
20 drives. However, they maintain that all deleted files have been recovered and preserved and  
21 that they have produced all information responsive to plaintiff's requests.

22 This court heard the matter on October 19, 2007. At the motion hearing, the court  
23 indicated that it was inclined to permit, at plaintiff's expense, some finite period for plaintiff to  
24 conduct discovery of bit-for-bit copies of defendants' hard drives; however, wholesale  
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26 <sup>2</sup> Verigy served identical requests (Request No. 17) on defendants, seeking "[a]  
27 bit for bit copy (in machine readable form) of all hard drives of all computers, including, but  
28 not limited to, desktop computers, laptop computers, USB memory devices, PDAs, and other  
memory storage devices that have been or are currently used by YOU." (See Morton Decl.,  
Exs. A and B).

production of the entire contents of the mirror images would not be allowed.<sup>3</sup> The court took a recess during which time the parties were directed to meet-and-confer on a discovery protocol that would allow for the protection of privileged and private material. They subsequently advised that they were unable to reach agreement; and, this court directed each side to submit its proposed protocol for consideration. Each side was also given an opportunity to file a supplemental letter brief.<sup>4</sup> Upon consideration of the moving and responding papers, as well as the arguments presented at the October 19, 2007 hearing, this court will adopt defendants' proposed protocol with some modification.

For the most part, the parties' proposed discovery protocols are virtually identical. Indeed, it appears that defendants have adopted many of plaintiff's proposed provisions verbatim. The main point of contention is whether defendants should be permitted an opportunity to review and object to any searches that plaintiff may wish to have the third party expert conduct. Defendants propose a two-tier protocol which (a) permits discovery in areas that defendants deem presumptively relevant; and (b) allows plaintiff to request that the expert conduct other searches, subject to an opportunity by defendant to review and object to the proposed search requests. Defendants express concern that plaintiff will propound unduly burdensome or otherwise abusive searches beyond the scope of permissible discovery under Fed.R.Civ.P. 26. At the motion hearing, it was suggested, somewhat facetiously, that Verigy might attempt to request a search for all documents with the letter "A." Indeed, documents submitted on supplemental briefing indicate that Verigy apparently has previously requested a

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<sup>3</sup> See, e.g., *In re Ford Motor Company*, 345 F.3d 1315 (11th Cir. 2003); *Ameriwood Indus., Inc. v. Liberman*, No. 4:06CV524, 2006 WL 3825291 (E.D. Mo., Dec. 27, 2006); *Balboa Threadworks, Inc. v. Stucky*, No. 05-1157, 2006 WL 763668 (D. Kan, Mar. 24, 2006); *Rowe Entertainment, Inc. v. The William Morris Agency, Inc.*, 205 F.R.D. 421 (S.D.N.Y. 2002); *Simon Property Group LP v. mySimon, Inc.*, 194 F.R.D. 639 (S.D. Ind. 2000); *Playboy Enterprises, Inc. v. Welles*, 60 F. Supp.2d 1050 (S.D. Cal. 1999).

<sup>4</sup> Although the parties were directed to file their respective supplemental briefs by noon on October 22, 2007, defendant's papers were not filed or received by this court's chambers until the end of the day. Based on defense counsel's representation that the delay was due to technical difficulties experienced by their office, this court has accepted and considered the belated filing.

1 search for all documents containing the letter "V" (*see* Pasquinelli Decl., Ex. C) – a request  
2 which strikes this court as being patently overbroad.

3 Verigy has not convincingly demonstrated that advance disclosure of its proposed  
4 searches would infringe any work product. Indeed, the record before the court indicates that  
5 plaintiff's counsel has previously provided a list of search terms and parameters to defense  
6 counsel. (*See* Pasquinelli Decl., Ex. C).

7 Verigy nonetheless protests that defendants have arbitrarily chosen words and phrases  
8 that meet with their approval, but omitted the majority of claimed trade secrets from the  
9 proposed search criteria. On the record presented, this court is unable to gauge the claimed  
10 arbitrariness of defendants' proposed search terms. In any event, defendants are not precluding  
11 plaintiff from conducting searches beyond the terms and parameters that defendants agree are  
12 presumptively relevant. Defendants simply want an opportunity to review plaintiff's proposed  
13 searches before the searches are executed – a request which comports with the normal conduct  
14 of discovery and which this court finds to be entirely reasonable.

15 As for Verigy's concerns about timing, this court will modify defendants' proposed  
16 protocol to minimize any delays which might result from disputes over proposed search terms.  
17 Although it should go without saying, the parties are admonished to proceed in good faith and  
18 to refrain from conduct designed to unnecessarily encumber or retard discovery or to impose  
19 unnecessary expense or burden on the opposing parties or the court.

20 Based on the foregoing, defendants' proposed protocol will be entered, with some  
21 modification, as an order of the court.

22 IT IS SO ORDERED.

23 Dated: October 24, 2007

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26 HOWARD R. LLOYD  
27 UNITED STATES MAGISTRATE JUDGE  
28

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